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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,051	02/15/2002	Pei-Yuan Zhou	50269-0516	6331
29989 7590 02/07/2007 HICKMAN PALERMO TRUONG & BECKER, LLP 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110			EXAMINER LOFTUS, ANN E	
			ART UNIT 3694	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/07/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/078,051	ZHOU ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ann Loftus	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.--

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 2/15/2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                                 |                                                                                         |
|-------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                            | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____                                                |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :12/12/06, 12/23/05, 4/20/05, 6/2/03, 7/23/02.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-72 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter, thus ineligible for patent protection.

An eligible invention must either physically transform an article or physical object to a different state or thing, or produce a useful, concrete and tangible result. If a claim is not directed to an article or physical object, then a relevant test for eligibility is whether the claimed invention as a whole is limited to a useful, concrete and tangible result.

The MPEP 2106 IV C (2) gives the following guidance to judge whether a result is useful, tangible and concrete:

- Useful – must be specific, substantial and credible and specifically recited in the claim. If the claim is broad enough to not require a practical application, it must be rejected.
- Tangible – must have a “real-world” result, not abstract.
- Concrete – must have a result that is substantially repeatable or the process must substantially produce the same result again.

As to claim 1, the result of the method claimed is the identity of a message sender. Identity means the distinguishing unvarying essential character of an individual

Art Unit: 3694

or thing. There is no substantial credible use for the identity specified in the claim. A determined identity is abstract, and not a real-world artifact, thus the result is not tangible. The claim does not meet the test for patent eligibility.

Later claims result in:

- billing a participant or
- determining a price, or
- decrementing an account balance or funds, or
- notice of denied access

which are tangible results. However, the result must also be credible and substantially repeatable. In many environments, intercepting a message is not credible nor substantially repeatable. Consider EDI (Electronic Data Interchange) messages on private networks, analog messages that guide missiles, navigational messages that direct aircraft, and radio messages. In order to reliably intercept a particular message between two random entities, a person of ordinary skill in the art would need access to the physical transmission media at a chokepoint. If the entire transmission media were to be disabled, the method would not be useful; therefore, a means to identify which message to intercept would also logically be required. The specification discusses a proxy server at an ISP (Internet Service Provider), where these elements are present, but the claim is not limited to a proxy server at an ISP.

Further, a reliable repeatable method of determining the sender's identity from the contents of an unspecified message form is not explained. Identity means the distinguishing unvarying essential character of an individual or thing. Messages

Art Unit: 3694

include everything from shortwave radio to carrier pigeons carrying flash drives. An entity that controls a transmission media may be able to determine account information from a properly constructed unencrypted message and its records, but determining an identity is an abstract goal. Messages can be rebroadcast with the sender information omitted or encrypted.

The examiner notes that determining an identity from an IP address is neither credible nor repeatable. Families and corporations and anyone who uses a library computer may share an IP address yet have separate identities. Further, many schemes that request identifying information are easily defeated. A credible method of reliably determining an identity from any message is not presented, therefore the method is not useful. A substantially repeatable process is not claimed, therefore the method is not concrete.

Functional descriptive material in combination with an appropriate computer readable medium must also produce a useful, concrete and tangible result as well. Claim 38, although independent, is thus rejected under the analysis above. The remaining claims are also rejected as depending on either claim 1 or claim 38.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3694

4. Claims 1-72 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claims 1 and 38, while a person who controlled Internet access could use a proxy server to intercept certain Internet messages where the proxy server formed a chokepoint, the claim is not limited to that circumstance. The claim is directed to intercepting messages and determining the sender's identity. The specification does not enable one to intercept any form of message and from it, determine the essential character of its sender.

Claims 2, 4, 17, 22, 39, 52 and 57 include steps that are only possible if the message can be deciphered, and the contents reveal the sought information. This implies an ability to decipher and interpret the contents and it implies that the contents include the necessary information, but these concepts are not addressed.

- Identifying which services are being provided to said client (2, 17, 52)
- Determining whether said message has billing implications (4, 39)
- Extracting a participant ID from the message (22, 57)

These are not enabled in the case where the message is encrypted, or the information is missing or otherwise indecipherable. One of ordinary skill in the art would not be able to perform these steps for all messages.

Art Unit: 3694

As to claims 8 and 43, it is unclear how a person of ordinary skill in the art would determine the funds available to a person sending a message. Consider a radio message or spam email that requests the service of clicking on a website from the audience. As above, determining the sender's identity is unreliable. Determining sufficient funds would presume some knowledge of the sender's accounts, but the claims are not limited to that situation.

As to claims 31 and 66, a person of ordinary skill in the art would be able to check an authorization source, if the service and its price were known and aforementioned problems were addressed. But this claim is directed to broader circumstances including when the service and price are unknown. In those circumstances, determining sufficient funds is not enabled.

The examiner notes that if the method were limited to a voluntary billing method or program, one would presume that participants would routinely agree to provide information in usable form. However, in a method or program for intercepting messages, it cannot be presumed that senders intend for their messages to be intercepted. In claim 3, billing on behalf of second parties implies some business agreement that would in turn imply that messages from service providers were meant to be usable.

The remaining claims are rejected due to inheriting the limitations of their parents.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.



6. Claims 1-72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Unclear language is rejected in order to clarify ambiguities.

As to claims 1 and 38, "determining the identity" is an abstract phrase as explained above, and is rejected as unclear. "Identifying the sender's account" may be closer to the intent of the claims. Also the phrase "intercepting a message" is unclear as to whether the message was delivered as intended or not. Within some communities, intercepting a message means to make a surreptitious copy of it rather than stopping its transmission. For the moment, the examiner will presume that the message is not delivered.

As to claims 13, 14, 48, and 49 "identity" is unclear, as above.

As to claims 15 and 50, it is unclear whose profile would be updated. Is this a profile for the service itself?

As to claims 16 and 51, it is unclear whose account balance would be affected.

As to claims 24 and 59, the term "the account balance" lacks antecedent basis. There is no account balance mentioned in its parent claims.

The remaining claims are rejected due to inheriting the limitations of their parents.

***Claim Rejections - 35 USC § 102***

Art Unit: 3694

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-72 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application Number 20020138331, filed on 5 Feb 2001, hereafter referred to as Hosea.

As to claims 1 and 38, Hosea teaches a proxy server which intercepts messages sent from a first participant to a second participant, where the first participant is a service requestor and the second participant is a service provider, and teaches determining the user and associated user profile on page 4, paragraphs 36 and 39.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3694

10. Claims 2-12, 14, 25, 26, 29, 30, 40-47, 49, 60, 61, 64, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosea in view of US Patent Application Number 20020133412, filed on 6 March 1998, hereafter known as Oliver, and further in view of the Federal Trade Commission's 16 CFR Ch 1 (1-1-98 edition) part 308, hereafter referred to as FTC.

As to claim 2, Hosea teaches the limitations of the parent claim. Hosea also teaches identifying which services are provided to clients by servers based on content on page 4, paragraph 37.

Hosea does not teach billing clients for services based on which services are provided. Oliver teaches such billing on page 5, paragraph 107. It would have been obvious to a person of ordinary skill in the art to combine intercepting messages with charging based on content based on the model of 900 numbers. 900 numbers work on a model where the service provider intercepts a message, identifies which services are requested and provided, and bills based on the content provided among other factors. See page 378, Definitions, from FTC, as evidence of this model.

As to claim 3, Hosea and FTC teach the parent claims as above. Oliver teaches the first party performing the step of billing on behalf of a set of second parties on page 1, paragraph 17.

As to claims 4 and 39, Hosea teaches the parent claim. Oliver teaches using a log to charge participants for services requested, on paragraphs 276 and 287 (page 11), and 300 (page 12). Oliver does not explicitly teach determining billing implications, however official notice is taken that a workable scheme for billing would have to avoid

Art Unit: 3694

billing if it was not warranted. FTC section 308.5 page 383 teaches determining billing implications. It would have been obvious to a person of ordinary skill in the art at the time of the invention to determine billing implications in order to avoid billing errors.

As to claims 5 and 40, Oliver teaches a log including a service requestor identification on page 11, paragraph 286.

As to claims 6 and 41, Oliver teaches a log including information to indicate how much the participant is to pay for the service on page 11, paragraph 287.

As to claims 7 and 42, Oliver teaches sending logs to an aggregation engine in paragraph 298, page 12.

As to claims 8-10, and 43-45, Oliver teaches a credit limit in the user profile on page 14, paragraph 331. This teaches determining sufficient funds. Official notice is taken that after determining sufficient or insufficient funds, it would have been obvious to a person of ordinary skill in the art to determine how to handle the message by either proceeding with the service request if funds are sufficient or else by sending a denial notice.

Oliver does not teach determining a need to pre-pay based on either the provider or client profiles. Official notice is taken that pre-paying for access to internet services is old and well known, for example by providing a credit card number that establishes a subscription. Oliver mentions supporting subscription type access on page 3, paragraph 46. It would have been obvious to a person of ordinary skill in the art at the time of the invention to determine a need for prepayment in the case of service providers who operate with subscriptions in order to handle billing for their content. Likewise, it is old

Art Unit: 3694

and well-known that some customers are in good standing and some are risky. It would have been obvious to a person of ordinary skill in the art at the time of the invention that some customers may need to pre-pay. Oliver in paragraph 291 on page 12 provides the ability to store tags in the profiles that define customer groups. It would have been obvious to a person of ordinary skill in the art at the time of the invention that such a tag could be used to denote customers who are required to prepay based on the profile.

As to claims 11 and 46, Oliver teaches a message with a price in paragraph 302, page 12.

As to claims 12 and 47, Oliver teaches providing content in paragraph 382 page 17.

As to claims 14 and 49, Oliver teaches a service class on paragraph 100 page 5. The service class would determine where to direct said message and what service is provided.

As to claims 25 and 60, FTC teaches awarding prizes to participants on page 380, right column, paragraph (c). FTC does not teach updating the profile to award the prize. Official notice is taken that to award a free services prize, the billing data would have to be adjusted for that participant. If the billing data for that participant was kept in a profile, then it would be obvious to update the profile. It would have been obvious to a person of ordinary skill in the art at the time of the invention to update the profile to award the service requestor a prize for having requested said service because otherwise the billing data in the profile would not reflect the prize and the bill would be in error.

Art Unit: 3694

As to claims 26 and 61, Hosea teaches in paragraph 42 page 4 generating a profile by tracking surfing activity. Hosea does not teach billing. Oliver teaches billing based on services, such as those tracked in such a profile. It would have been obvious to a person of ordinary skill in the art at the time of the invention to store a number in the profile representing the number of times the service requestor has requested a service and increment it and store it back into the profile, and then determine whether to bill the service requestor for the service based on the number. This is a simple way to track the number of services requested, which helps the service provider determine volume. The 900 number services would track a number of minutes, increment it and store it with a customer's information to generate a bill.

As to claims 29, 30, 64 and 65, Oliver in paragraphs 329-333, page 14, teaches a credit limit in the profile which is checked before the service request is put through. Official notice is taken that online shopping typically includes many validation steps where the participant can confirm or abandon the service request. FTC on page 379, left column, paragraph (2) teaches that providing a credit card number is a form of pre-authorization for services. It is old and well-known to present the participant with a bill, then request a credit card number(pre-authorization), then ask for a final authorization of the bill. It would have been obvious to a person of ordinary skill in the art at the time of the invention to check a profile to determine whether pre-authorization is required, then send the service requestor a payment authorization message, and if payment is authorized, to put through the service request to the service provider.

Art Unit: 3694

11. Claims 13, 15-24, 27, 28, 33-37, 48, 50-59, 62,63, and 66-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosea in view of Oliver.

As to claims 13, and 48, Hosea teaches the parent claims. Oliver teaches a service class on paragraph 100 page 5. The service class would determine where to direct said message and what service is provided.

As to claims 15 and 50, Oliver, paragraphs 203 to 215, page 9, teaches updating user profiles. Oliver paragraph 389 teaches logging requested services. Oliver does not teach updating profiles based on the services requested. Official notice is taken that it is old and well-known to determine user preferences by services requested and to store the preferences in a user profile, as Oliver does in paragraph 259, page 10. It would have been obvious to a person of ordinary skill in the art at the time of the invention to update a profile with new preferences based on the services requested.

As to claims 16, 24, 51 and 59, Oliver teaches decrementing (settling) accounts when the service requestor accesses the service and the service requires a fee on paragraph 9 page 1 and 298, page 12.

As to claims 17 and 52, Hosea teaches identifying which services are provided to clients by servers based on the message on page 4, paragraph 37.

As to claims 18 and 53, Oliver teaches locating a profile based on the first participant in paragraph 350, page 15.

As to claims 19, 23, 54 and 58, Oliver does not teach storing billing data in the profile because the TVS user profile is passed to a plurality of merchants. Oliver does teach a "home" service provider with a billing relationship to the service requestor in



Art Unit: 3694

paragraph 17, page 1. Official notice is taken it is old and well known for the home provider to maintain customer profiles containing billing data and account balances. It would have been obvious to a person of ordinary skill in the art at the time of the invention to store billing data and account balances associated with the service requester in a profile in order to be able to generate bills with the correct addresses and accounts.

As to claims 20 and 55, Oliver teaches pricing data in the profile in paragraph 256 and 257, page 10. This is used to determine a price that the service requestor will pay for a service.

As to claims 21 and 56, Oliver teaches that a home service provider bills the service requestor and other service providers bill the home service provider (abstract). Whether a particular service requestor should be billed by a service provider depends upon the profile field in paragraph 250, page 10. Thus Oliver teaches billing the service requestor if the profile indicates that the service requestor is to be billed.

As to claims 22 and 57, Hosea teaches in paragraph 39 on page 4 extracting a participant ID from a message and using it to locate a profile.

As to claims 27 and 62, Oliver teaches determining whether the service requestor is allowed access based on the profile in paragraph 254, page 10.

As to claims 28 and 63, Oliver teaches denying a resource to a requestor in paragraph 332, page 14. Oliver does not teach sending a message indicating that access is not allowed. Official notice is taken that it is old and well known to send messages explaining services that are unavailable in order to reduce customer



Art Unit: 3694

confusion when possible. It would have been obvious to a person of ordinary skill in the art at the time of the invention to send such a message to explain the denial and minimize discomfort for the participant.

As to claims 31, 33, 66 and 68, Oliver in paragraphs 329-333, page 14 teaches determining whether the service requestor has funds to pay for a service based on an authorization source which is in the profile.

As to claims 32 and 67, Oliver in paragraph 330 teaches an account linked to a debit card. This would allow the funds to be decremented from a requestor account associated with the service requestor.

As to claims 34, 35, 69 and 70, Oliver in paragraphs 329-333, page 14 teaches determining sufficient funds based on a credit limit in a profile. Oliver does not teach an authorization source of a billing scheme or billing system. Official notice is taken that it is old and well known to determine sufficient funds by querying a billing scheme or billing system. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the billing scheme or system as an authorization source to set the credit limit in the profile, because the most current information about the customer is likely to be there.

As to claims 36 and 71, Oliver teaches an invention that requires passing a token between authorized partners (paragraph 16, page 1). Oliver does not teach determining whether the service provider is an authorized partner before retransmitting the message. Official notice is taken that it was old and well known to limit service to authorized partners. It would have been obvious to a person of ordinary skill in the art at

Art Unit: 3694

the time of the invention to determine whether the service provider is an authorized partner before retransmitting the message in order to limit business to authorized partners.

As to claims 37 and 72, Oliver teaches a secure connection and authentication in paragraph 365, page 16.

Art Unit: 3694

**Conclusion**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Loftus whose telephone number is 571-272-7342. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AL 2/5/07

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